



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/760,794  | 01/17/2001  | Jurgen Sienel        | Q62127              | 4939             |
| 7590  | 06/29/2004  |                      | EXAMINER            |                  |
| SUGHRUE, MION, ZINN,<br>MACPEAK & SEAS, PLLC<br>2100 Pennsylvania Avenue, N.W.<br>Washington, DC 20037-3213 |             |                      | NGUYEN, TU X        |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2684                |                  |
| DATE MAILED: 06/29/2004   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |               |
|------------------------------|-----------------|---------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)  |
|                              | 09/760,794      | SIENEL ET AL. |
| Examiner                     | Art Unit        |               |
| Tu X Nguyen                  | 2684            |               |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11/20/04.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 11 and 12 is/are pending in the application.

4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 11 and 12 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

|   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Response to Amendment***

1. Applicant's arguments with respect to claims 11-12 have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Yahusaki et al. (US Patent 5,513,211).

Regarding claims 11-12, Yahusaki et al. disclose a telecommunication system comprising :

a switch (see col.3 lines 13-15);

a mobile first terminal having a first preprocessing unit (see col.5 line 64 through col.6 line3 and col.6 lines 21-24, 45-46);

a mobile second terminal having no preprocessing unit (see col.3 lines 39-51, this terminal has a voice code which provide more useful function not less than the claim limitation. Also in a particular scenario, it meets the claim limitation because no code conversion, code release mode, is effected for the communication between

terminals which use the same voice code or without voice code in each terminals so that the distortion by the conversion and the delay time as cited by Yahusaki);

a fixed third terminal having a second preprocessing unit (see col.6 lines 55-56);

a fixed fourth terminal having no preprocessing unit (see col.3 lines 39-51, this terminal has a voice code which provide more useful function not less than the claim limitation. Also in a particular scenario, it meets the claim limitation because no code conversion -code release mode- is effected for the communication between terminals which use the same voice code or without voice code in each terminals so that the distortion by the conversion and the delay time as cited by Yahusaki);

a final processing unit (7<sub>1,2</sub> fig.2 and col.3 lines 52-67);

means for coupling a first side of said switch to a first and a second mobile switching center (4 fig.1) and to said third and fourth terminals (1, fig.1);

means for coupling said first mobile switching center (4, fig.1) to a first base station (3,fig.1) for radio communication with said first terminal (2,fig.1);

means for coupling said second mobile switching center (4<sub>2</sub> ,fig.2) to a second base station (3<sub>2</sub> ,fig.2) for radio communication with said second terminal (2<sub>2</sub> ,fig.2);

means for coupling a second side of said switch to said final processing unit (7<sub>1,2</sub> 6<sub>1,2</sub> fig.2);

a third and a fourth (1, fig.1) preprocessing unit associated with said switch;

means for connecting said third preprocessing unit (4, 1 fig.1);

means for connecting said third preprocessing unit to said second mobile switching center (see 1,4 and fig.1,2); and

means for connecting said fourth preprocessing unit to said fixed fourth terminal (see col.3 lines 1-67),

so that said switch operates in a same manner for switching speech signals among said first, second, third and fourth terminals and to said final processing unit (see col.2 lines 10-39).

### Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu Nguyen whose telephone number is (703) 305-3427. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MAUNG NAY A, can be reached at (703) 308-7749.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 Customer Service Office at (703) 306-0377.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9314 (Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

*TN*  
June 16, 2004

*Nay Maung*  
NAY MAUNG  
SUPERVISORY PATENT EXAMINER